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**DEC 17 2007**

**OFFICE OF PETITIONS**

WESTMAN CHAMPLIN & KELLY, P.A.  
SUITE 1400  
900 SECOND AVENUE SOUTH  
MINNEAPOLIS MN 55402-3319

In re Application of :  
Ibrahim, et al. :  
Application No. 10/589,542 : DECISION  
Filed: 16 August, 2006 :  
Attorney Docket No. W51.12-0033 :

This is a decision on the petition filed on 21 September, 2007, under 37 C.F.R. §1.47(b).

For the reasons set forth below, the petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

**NOTES:**

Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";

Thereafter, there will be no further reconsideration of this matter.

**BACKGROUND**

The record indicates:

- the instant application was filed on 16 August, 2006, without, *inter alia*, a fully executed oath/declaration;

- on 23 April, 2007, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration (signed and dated) was required;
- on 21 September, 2007, Petitioner David D. Brush (Reg. No. 34,557) submitted, *inter alia*, an oath/declaration executed by the averred authorized official of assignee and his averment of interest in the application (but there does not appear to be a statement as to irreparable harm/danger), with the instant petition under 37 C.F.R. §1.47(b), however, it appears from the documents thusfar submitted by Petitioner that only the oath/declaration and assignment and not the entire application (description, claims abstract and drawings), as required by law, were sent to the two non-signing inventors, Nicholas Ibrahim and Dragabn Vujcic (Messrs. Ibbrahim and Vujcic), in that is the statement contained in the transmittal documents.

In addition, because nearly a year elapsed between the time at which oath/declaration/assignment documents were sent by Petitioner to the inventors, Petitioner is respectfully requested to ensure that a diligent effort confirms the validity of the addresses provided to the Office.

### ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

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(b) Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in § 1.17(g), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with § 1.63.

\* \* \*

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

**§1.63 Oath or declaration.**

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

(1) Identify the application to which it is directed;

(2) State that the person making the oath or declaration has reviewed and understands the contents of the application, Including the claims, as amended by any amendment specifically referred to in the oath or declaration; and

(3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

When one alleges a refusal of the inventor to sign the application papers, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who, *inter alia*, presented the inventor with the application papers and/or to whom the refusal was made. Petitioner is directed to the commentary at MPEP §409.03(d), which provides in pertinent part:

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

Further, the guidance in the Commentary at MPEP §409.03(b)(A) and (B) provide in pertinent part:

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In addition to other requirements of law (35 U.S.C. §§111(a) and 115), an application deposited pursuant to 37 C.F.R. §1.47(b) must meet the following requirements:

(A)The 37 C.F.R. §1.47(b) applicant must make the oath required by 37 C.F.R. §1.63 and §1.64 or §1.175. Where a corporation is the 37 C.F.R. §1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the

application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973).

Where an application is executed by one other than the inventor, the declaration required by 37 C.F.R. §1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 C.F.R. §1.47(b).

(B)The 37 C.F.R. §1.47(b) applicant must state his or her relationship to the inventor as required by 37 C.F.R. §1.64. (Emphasis supplied.)

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Thus, Petitioner must submit an executed oath/declaration and support that document by a certificate under 37 C.F.R. §3.73(b).

Moreover, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application—and evidence of that transmittal submitted—but also a reasonable effort must be made to ascertain a current or last known address, which information is to appear over the signature and registration number of the Petitioner along with evidence of the due diligence effort ascertaining same.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

(The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.<sup>3</sup>)

Petitioner's attention is directed to the discussion in the BACKGROUND and ANALYSIS, above, and should ensure that the deficiencies addressed there are corrected with any future petition herein, to include (but not necessarily be limited to) the requirements that a copy of the transmittal letter forwarding the entire application (description, claims, abstract and drawings) to, and evidencing reasonable diligence in ascertaining a reasonably believed last known/current address for the non-signing inventor, all as required by law.

Thus, any renewed petition by Petitioner must include:

- the required showing under 37 C.F.R. §3.73(b);

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<sup>3</sup> See: MPEP 409.03(b).

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- evidence that the oath/declaration and assignment and not the entire application (description, claims abstract and drawings), as required by law, were sent to the two non-signing inventors, Messrs. Ibrahim and Vujcic;
- demonstrated due diligence as required to ascertain an address to be used/supplied for the non-signing inventor (i.e., a residence address) is current or at the very least the most reasonably believed to be last known address for the non-signing inventor(s).

It is suggested that Petitioners might review and move stepwise through the guidance in the Commentary at MPEP §409, et seq., and satisfy themselves that all the elements have been addressed completely.

### CONCLUSION

Therefore, the instant petition hereby is **dismissed**.

Further correspondence with respect to this matter should be addressed as follows:<sup>4</sup>

By mail: Commissioner for Patents<sup>5</sup>  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>6</sup>) and the

<sup>4</sup> On July 15, 2005, the Central Facsimile (FAX) Number changed from (703) 872-9306 to (571) 273-8300. Old number(s) no longer are in service and (571) 273-8300 is the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

<sup>5</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).


<sup>6</sup> The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written

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proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.